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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/530,070      | 08/29/2005  | Dietmar Muller       | 0740-71             | 7543             |

616 7590 07/27/2006

THE MAXHAM FIRM  
750 "B" STREET, SUITE 3100  
SAN DIEGO, CA 92101

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| EXAMINER |
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YOUNG, JANELLE N

|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2618

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/530,070             | MULLER ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Janelle N. Young       | 2618                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Drawings*

1. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

Applicant is given a TWO MONTH time period to submit a drawing in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit a drawing will result in **ABANDONMENT** of the application.

### *Specification*

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet **within the range of 50 to 150 words**. It is important

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that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The disclosure is objected to because of the following informalities: the word "mobil" (page 2, line 8) is misspelled the word should read "mobile". the word "Telematik" (page 5, line 6) is misspelled the word should read "Telematic". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilson et al. (US Patent 2004/0203903).

As for claim 9, Saunders et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, comprising: the terminal device configured to only establish connections to fixed destination or source addresses, or both; the destination and source addresses permissible in connection with the SIM card are stored in a memory of the SIM card or in a database of the mobile communication network (Abstract; Page 3, Para 0047; Page 4, Para 0055 & 0062; Page 5, Para 0067; Page 9, Para 0108; Page 12, Para 0129; and Page 15, Para 0163).

As for claims 10 & 28-32, Saunders et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein said SIM card is designed as a Telematic SIM card and wherein the SIM card supports other services that are typically not understood to be Telematic services (Page 1, Para 0003-0004).

As for claims 11-12, Saunders et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein the destination and source addresses are phone numbers, URLs (Uniform Resource Locator) or APN's (Access Point Name) (Page 5, Para 0067; Page 6, Para 0077; and Page 14, Para 0155).

As for claims 13-16, Saunders et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein the SIM card only supports defined telecommunication services (Abstract; Page 12, Para 0129; and Page 15, Para 0163).

As for claims 17-21, Saunders et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein the mobile phone subscriber relationship associated with the SIM card can only be operated within a defined virtual private network (VPN) (Abstract; Page 12, Para 0129; and Page 15, Para 0163 with respect to Page 3, Para 0053).

As for claims 22-27, Saunders et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein the SIM card encompasses more than one different subscriber relationship, wherein the use of the SIM card is assigned according to the originator principle to the respective subscriber relationship (Abstract; Page 2, Para 0045; Page 3, Para 0051; Page 4, Para 0056; Page 5, Para 0066; Page 9, Para 0104; Page 12, Para 0129; and Page 15, Para 0163).

Regarding claim 33, see explanation as set forth regarding claim 1 (device claim) because the claimed process/method for a SIM card for operation with a terminal device of a mobile telecommunication network would perform the device steps.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle N. Young whose telephone number is (571) 272-2836. The examiner can normally be reached on Monday through Friday: 8:30 am through 4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on (571) 272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 7/24/06

QUOCHIEN B. VUONG  
PRIMARY EXAMINER

JNY  
July 20, 2006